

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Rice *et al.*

Application No. 10/017,323

Filed: December 13, 2001

For: BENZOYLALKYLINDOLEPYRIDINIUM  
COMPOUNDS AND PHARMACEUTICAL  
COMPOUNDS COMPRISING SUCH  
COMPOUNDS

Examiner: Not yet assigned


Date: June 20, 2002



Art Unit: 1619

CERTIFICATE OF MAILING

I hereby certify that this paper and the documents referred to as being attached or enclosed herewith are being deposited with the United States Postal Service on June 20, 2002 as First Class Mail in an envelope addressed to: BOX MISSING PARTS, COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231.

  
Stacey C. Slater  
Attorney for Applicant

BOX MISSING PARTS  
COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

**DECLARATION OF STACEY C. SLATER**

Dear Sir:

Stacey C. Slater, having personal knowledge of the facts set forth below, declares as follows:

1. I have been informed that embodiments of the invention claimed by the referenced application were conceived and reduced to practice by the inventors while Drs. William Rice, Mingjun Huang, Robert Buckheit Jr., David Covell, Christopher Michejda and Grzegorz Czerwinski were employed by the National Institutes of Health (NIH) of Bethesda, Maryland, and while Dr. Vadim Makarov was employed by Gram Limited of Moscow, Russia.
2. I prepared the present application, No. 10/017,323, which was filed on December 13, 2001. The application was filed without signature.
3. Based on information received from the inventors, I understand that the compound referred to in method claim 7 as filed with the referenced application was submitted

to the NIH for biological testing by Dr. Makarov. I further understand, based on information received from Dr. Makarov by e-mail, that he selected the compound for submission to the NIH for biological testing, synthesized a sample and submitted it to the NIH for testing. The compound had been synthesized previously, apparently by Mrs. Svetlana Ryabova, but the structure of the compound itself is not being claimed in the present application. Although Dr. Makarov had not received the results of the biological analyses performed by one or more of the coinventors named on this application, a reasonable assumption is that he considered the compound biologically active upon submission to the NIH, and further that a method for exploiting the biological activity of such compound had been conceived by Dr. Makarov prior to such compound being submitted to the NIH for biological testing. In view of my understanding of the facts of this matter, and the holding by the Federal Circuit in *Burroughs Wellcome v. Barr Laboratories Inc.*, 32 USPQ2d 1915 (Fed. Cir. 1994), it appears that Dr. Makarov should be named as a coinventor of the application referenced above.

4. Dr. Makarov stated that he would not participate in a United States patent application, apparently because it might cause some personal hardship. The nature of this hardship has never been entirely clear, primarily as a result of the language barrier.

4. On April 15, 2002, Devon Zastrow of our firm sent a cover e-mail, an attached copy of the referenced application, a Combined Declaration and Power of Attorney, and an Assignment to Dr. Makarov at his last known e-mail address, *makar-cl@ropnet.ru*. A copy of our firm's letter and the e-mail is attached to this Declaration.


6. On April 16, 2002, Dr. Makarov replied by e-mail, stating, without correction:

I am not invertor (sic) of this work. Please exclude me from list of inventors. As I informed NIH early I can not sing (sic) the Combined Declaration and Power of Attorney, and the National Institutes of Health (NIH) has prosecute (sic) the application without my participation.

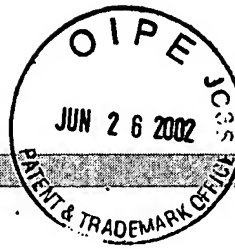
A complete copy of Dr. Makarov's reply e-mail message is attached.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By   
Stacey C. Slater  
Registration No. 36,011

One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Telephone: (503) 226-7391  
Facsimile: (503) 228-9446



**Devon Zastrow**

**From:** Devon Zastrow  
**Sent:** Monday, April 15, 2002 10:44 AM  
**To:** 'makar-cl@ropnet.ru'  
**Cc:** 'HuS@OD.NIH.GOV'; Stacey Slater  
**Subject:** BENZOYLALKYLINDOLEPYRIDINIUM COMPOUNDS AND PHARMACEUTICAL COMPOSITIONS COMPRISING SUCH COMPOUNDS

**Importance:** High

April 15, 2002

**VIA E-MAIL ONLY** (to [makar-cl@ropnet.ru](mailto:makar-cl@ropnet.ru))

*No confirmation copies will follow*

**Re:** New U.S. Utility Application  
**For:** BENZOYLALKYLINDOLEPYRIDINIUM COMPOUNDS AND  
PHARMACEUTICAL COMPOSITIONS COMPRISING SUCH COMPOUNDS  
**First Inventor:** Rice  
**NIH (DHHS) Ref No.** E-091-01/1  
**Our Ref No:** 4239-61858

Dear Dr. Makarov:

Please see the attached letter regarding the referenced U.S. utility patent application. A copy of the application as filed is attached, along with a Combined Declaration and Power of Attorney. If you decide to sign the attached Combined Declaration and Power of Attorney and proceed with the U.S. application, please sign and add your address using blue ink. As explained in the letter, if you do not sign the Combined Declaration and Power of Attorney, the National Institutes of Health (NIH) likely will prosecute the application without your participation.

Also attached is an Assignment, which if signed would formally convey your rights in this invention to the NIH. If you believe you have a duty to assign your rights in this invention to the NIH, or if you wish to do so, please sign and date the Assignment in blue ink. Your signature on the Assignment is not required to prevent the referenced patent application from going abandoned.

Please let us know how you intend to proceed concerning signing these documents by replying to this e-mail by **April 24, 2002**. If we do not hear from you by this date, we will assume that you will not sign the attached documents, and the NIH will proceed without your participation.

Let us know if you have any questions concerning how to execute the attached documents.

Stacey C. Slater, J.D.  
Devon J. Zastrow, J.D.

Klarquist Sparkman, LLP  
One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, OR 97204  
Tel. 503-226-7391 ext. 375  
Fax 503-228-9446  
email:devon.zastrow@klarquist.com

This e-mail contains confidential and/or privileged information intended only for the addressee. If you have received this communication in error, please call us collect at 503-226-7391 and ask to speak to the sender. Also, please notify the sender via e-mail that you have received the communication in error.



Letter.doc



Patent  
Application.doc



Comb Dec &  
POA.doc



Assignment.doc

Lisa M. Caldwell  
James E. Geringer  
Michael P. Girard  
Joseph T. Jakubek  
Ramon A. Klitzke II  
William D. Noonan, M.D.  
David P. Petersen  
Richard J. Polley  
Robert F. Scotti  
Stacey C. Slater  
Donald L. Stephens, Jr.  
John W. Stuart  
John D. Vandenberg  
Arthur L. Whinston  
Stephen A. Wight  
Garth A. Winn

*Senior Counsel*  
Kenneth S. Klarquist  
James S. Leigh

*Of Counsel*  
Jeffrey S. Love

# KLARQUIST SPARKMAN, LLP

*Intellectual Property Legal Services  
Including Patents, Trademarks, Copyrights & Litigation  
Since 1941*



One World Trade Center  
121 S.W. Salmon Street, 16<sup>th</sup> Floor  
Portland, Oregon 97204-2988 U.S.A.  
Fax: 503-228-9446  
Telephone: 503-226-7391  
[www.klarquist.com](http://www.klarquist.com)

Steven Alexander  
\*Patrick M. Bible  
\*Daniel B. Burg  
J. Christopher Carraway  
Kristin L. Cleveland  
Joel C. Corcoran  
\*Scott E. Davis  
Jeffrey B. Haendler  
Tanya M. Harding, Ph.D.  
Kevin M. Hayes  
Stephen J. Joncus  
Michael D. Jones, Ph.D.  
Gregory L. Maurer  
\*Richard D. McLeod  
\*Charles A. Mirho  
Kyle B. Rinehart  
Wayne W. Rupert  
Devon J. Zastrow

*Registered Patent Agents*  
Gillian Bunker, Ph.D.  
Anne Carlson, Ph.D.  
David E. Orr, Ph.D.  
Sheree Lynn Rybak, Ph.D.  
Susan Alpert Siegel, Ph.D.

*Technical Consultants*  
Daniel H. Bell  
Aden A. Rehms, Ph.D.  
Travis Young, Ph.D.

*\*Not a Member of the Oregon Bar*

## CONFIDENTIAL

May 17, 2002

*Via Email Only to [makar-cl@ropnet.ru](mailto:makar-cl@ropnet.ru)*

**No Confirmation Copies Will be Sent**

RE: New U.S. Utility Patent Application  
For: BENZOYLALKYLINDOLEPYRIDINIUM COMPOUNDS AND  
PHARMACEUTICAL COMPOSITIONS COMPRISING SUCH  
COMPOUNDS

First NIH Inventor: Rice  
Filed December 13, 2001  
NIH (DHHS) Ref. No. E-091-01/2  
Our Ref. No. 4239-61858

Dear Dr. Makarov:

We are intellectual property counsel representing the National Institutes of Health (NIH) to prosecute the referenced United States utility patent application. We understand, from our previous e-mail correspondence, and from information provided by the NIH, that you may not be allowed to claim and/or assign your rights in this invention, nor participate in the prosecution of any patent applications filed that are directed to this invention. While we understand your situation, the NIH has instructed us to continue to seek protection of its intellectual property.

Attached is a copy of the application as filed by the NIH. Please acknowledge receipt of this correspondence by return e-mail.

You were named as an inventor on the U.S. application based upon our understanding of the facts concerning the conception and reduction to practice of the claimed invention. In the United States, inventors are required to sign a Declaration stating that the inventor has read and understood the application, including the claims, as filed. The inventors also need to provide

Dr. Vadim Makarov  
Our Ref. No. 4239-61858  
May 17, 2002  
Page 2

Power of Attorney to those representing the inventors before the United States Patent and Trademark Office. Attached is a Combined Declaration and Power of Attorney for your review.

Please review the U.S. utility application and the Combined Declaration and Power of Attorney. After you have completed your review, please (1) sign the document, stating that you have read and understood the application as filed, and granting us Power of Attorney to prosecute these applications on your behalf, or (2) let us know that you cannot or will not sign, such as by return e-mail.

In the United States, C.F.R. § 1.47 allows an inventor to continue prosecution of an application if a co-inventor refuses to sign. Therefore, if you refuse to sign the documents required for the United States application, the remaining inventors can, and likely will, prosecute this application unless instructed otherwise by the National Institutes of Health.

We must file the Combined Declaration and Power of Attorney with the United States Patent Office to respond to a Missing Parts Notice that will soon issue concerning the U.S. utility application. Therefore, please reply to this letter at your earliest convenience.

In addition, you should know that the NIH filed a Patent Cooperation Treaty (PCT) application directed to this invention on December 13, 2001, but has decided not to prosecute this application. Therefore, the PCT application will go abandoned in due course for failure to prosecute. This likely will mean that patent protection for the invention claimed in this PCT will be forfeited for countries other than the United States.

We remind you that we do not represent you as a client. We represent the NIH. As such, you should seek the advice of separate intellectual property counsel if you have any questions concerning your rights in this matter.

Sincerely,

KLARQUIST SPARKMAN, LLP

Stacey C. Slater

SCS/DJZ:kam

cc: Sally Hu, Ph.D., M.B.A.  
William D. Noonan, M.D.  
Devon J. Zastrow, Esq.

Dr. Vadim Makarov  
Our Ref. No. 4239-61858  
May 17, 2002  
Page 3





**Devon Zastrow**

**From:** Makarov Vadim [makar-cl@ropnet.ru]  
**Sent:** Tuesday, April 16, 2002 2:21 AM  
**To:** Devon Zastrow  
**Subject:** Re: BENZOYLALKYLINDOLEPYRIDINIUM COMPOUNDS AND  
PHARMACEUTICAL COMPOSITIONS COMPRISING SUCH COMPOUNDS

**Importance:** High

Dear Mr. Zastrow,

I am not inventor of this work. Please exclude me from list of inventors. As I informed NIH early I can not sign the Combined Declaration and Power of Attorney, and the National Institutes of Health (NIH) has prosecute the application without my participation.

Sincerely Yours  
Dr. VadimMakarov

At 11:43 15-04-02 -0700, you wrote:  
April 15, 2002

VIA E-MAIL ONLY (to [makar-cl@ropnet.ru](mailto:makar-cl@ropnet.ru))  
No confirmation copies will follow

Re: New U.S. Utility Application  
For: BENZOYLALKYLINDOLEPYRIDINIUM COMPOUNDS AND  
PHARMACEUTICAL  
COMPOSITIONS COMPRISING SUCH COMPOUNDS  
First Inventor: Rice  
NIH (DHHS) Ref No. E-091-01/1  
Our Ref No: 4239-61858

Dear Dr. Makarov:

Please see the attached letter regarding the referenced U.S. utility patent application. A copy of the application as filed is attached, along with a Combined Declaration and Power of Attorney. If you decide to sign the attached Combined Declaration and Power of Attorney and proceed with the U.S. application, please sign and add your address using blue ink. As explained in the letter, if you do not sign the Combined Declaration and Power of Attorney, the National Institutes of Health (NIH) likely will prosecute the application without your participation.

Also attached is an Assignment, which if signed would formally convey your rights in this invention to the NIH. If you believe you have a duty to assign your rights in this invention to the NIH, or if you wish to do so, please sign and date the Assignment in blue ink. Your signature on the Assignment is not required to prevent the referenced patent application from going abandoned.

Please let us know how you intend to proceed concerning signing these documents by replying to this e-mail by April 24, 2002. If we do not hear from you by this date, we will assume that you will not sign the attached documents, and the NIH will proceed without your participation.

Let us know if you have any questions concerning how to execute the attached documents.

Stacey C. Slater, J.D.

Devon J. Zastrow, J.D.  
Klarquist Sparkman, LLP  
One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, OR 97204  
Tel. 503-226-7391 ext. 375  
Fax 503-228-9446  
email:devon.zastrow@klarquist.com

This e-mail contains confidential and/or privileged information intended only for the addressee. If you have received this communication in error, please call us collect at 503-226-7391 and ask to speak to the sender. Also, please notify the sender via e-mail that you have received the communication in error.

<<Letter.doc>> <<Patent Application.doc>> <<Comb Dec & POA.doc>>  
<<Assignment.doc>>

Attachment Converted: C:\RESERV\Letter.doc

Attachment Converted: C:\RESERV\PatentAp.doc

Attachment Converted: C:\RESERV\CombDec&.doc

Attachment Converted: C:\RESERV\Assignme.doc

Dr. Vadim Makarov  
Department of Medicinal Chemistry  
NIOPIK  
B.Sadovaya str., 1, block 4,  
Moscow 103787 Russia  
Tel: 007(095)254-9724  
Fax: 007(095)243-0871  
e-mail: [makar-cl@ropnet.ru](mailto:makar-cl@ropnet.ru)